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In re Application of
DOUGLAS, Paul
U.S. Application No.: 10/550,036
PCT No.: PCT/GB2004/001185
Int. Filing Date: 18 March 2004
Priority Date: 21 March 2003
Attorney Docket No.: 7881.18
For: JAW CRUSHER

DECISION

This decision is in response to the "Renewed Petition Under 37 CFR §1.47(b)" filed 18 September 2007.

BACKGROUND

On 19 March 2007, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Applicant was given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 18 September 2007, applicant submitted a renewed petition under 37 CFR 1.47(b) which was accompanied by, *inter alia*, a four-month extension of time with fee and exhibits A - J.

DISCUSSION

As previously noted, a petition under 37 CFR 1.47(b) requires (1) a petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be located, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Items (1) and (3) of 37 CFR 1.47(b) were completed in the initial petition.

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP) states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In the petition, the 37 CFR 1.47(b) applicant includes such a statement. Thus, item (6) is complete.

Regarding item (2), the 37 CFR 1.47(b) applicant claims that the sole inventor, Paul Douglas, refuses to cooperate. As previously noted, petitioner's burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. A pertinent segment is listed below:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. **If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. (Emphasis added)**

The "Witness Statement" by Mr. Martin Mark Neilson dated 05 September 2007 indicates that a complete copy of the application was forwarded to Mr. Douglas on 22 August 2007. Petitioner states that the documents were delivered on 25 August 2007. A review of the evidence verifies that a complete copy of the international application was received by Mr. Douglas on 25 August 2007. In the affidavit, Mr. Neilson states that no response has been received from the nonsigning inventor or Walker Morris, his representatives.

However, in a similar U.S. application (No. 10/550,035), Mr. Neilson in a "Witness Statement" dated 18 October 2007 states that Walker Morris has contacted them by letter on 25 September 2007 and requests certain monies for Mr. Douglas's cooperation. As requested in the decision mailed in U.S. application No. 10/550,035, petitioner must provide copies of all the correspondence with Walker Morris concerning the subject application. This evidence is required to make a determination whether a refusal to cooperate has occurred. *See above in bold.*

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied:

Regarding item (4), the 37 CFR 1.47(b) applicant provided a declaration listing the name, residence, mailing address and citizenship of the sole inventor. The declaration was signed by Evan R. Witt, the attorney for applicant on behalf of the inventor. A power of attorney signed by the Director of Extec Screens and Crushers Limited was provided. This is not sufficient. Section 409.03(b) of the MPEP states that "[w]here the oath or declaration is being signed on behalf of an assignee, see MPEP § 324." Section 324 of the MPEP states, in part:

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii) . . . A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, **if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee.** 37 CFR 3.73(b)(2)(i).

An attorney is not a position that is assumed to have the authority to sign for the assignee. Moreover, Mr. Witt has not set forth that he is authorized to act on behalf of the assignee. The power of attorney is not sufficient in this regard. As such, item (4) is not yet satisfied.

With regards to item (5), section 409.03(f) of the MPEP states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b) a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, the 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned national stage application of PCT/GB2004/01185 because the inventor made the invention while he was an employee of INHOCO 2723 Ltd. (INHOCO) and had signed an employment agreement ("Agreement") transferring any invention to INHOCO. The 37 CFR 1.47(b) applicant also submitted an extract (Exhibit H) confirming that INHOCO changed its name to Extec Holdings Limited on 18 February 2003. Extec Holdings Limited assigned its interest in the subject application to Extec Screens and Crushers Ltd. on 17 September 2007 (Exhibit J).

A review of the Agreement shows that it was dated 11 December 2002 and signed by Mr. Douglas. Section 14.2 of the Agreement provides that any invention created or discovered by Mr. Douglas in the course of the employment shall belong to INHOCO. The Witness Statement by Mr. Ian Frazier submitted as exhibit F states that "[t]he three US patent applications . . . name Paul Douglas as inventor or co-inventor, and have been derived from International patent applications made in the name of Extec . . . as applicant, also naming Paul Douglas as inventor." However, the 37 CFR 1.47(b) applicant has not provided a statement of a person having firsthand knowledge of the facts that the invention was made by Mr. Douglas in the scope of his duties while employed by the 37 CFR 1.47(b) applicant (or assignee).

The 37 CFR 1.47(b) applicant also provided a copy of an assignment (Exhibit I) dated 31 August 2005 whereby Paul Douglas assigned all his interest in Extec Holdings Limited to Extec Holdings Limited. However, the above-captioned application was first submitted as a British patent application (0306491.2) on 21 March 2003. The assignment was not signed until 31 August 2005 and it is vague as to what intellectual property rights it encompasses. Thus, it is not clear whether this assignment applies to the subject application. A legal memorandum prepared by an attorney familiar with the law of the jurisdiction involved as discussed in section 409.03(f) of the MPEP may be required to certify that the subject invention was transferred to the 37 CFR 1.47(b) applicant.

For these reasons, item (5) is also not yet satisfied.

All of the requirements of 37 CFR 1.47(b) are not yet complete.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time are available.

10/550,036

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in cursive script, appearing to read "James Thomson".

James Thomson
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